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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,738	11/15/2001	Rolf Schaer	P 01-12	2707

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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/003,738	SCHAER ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *28022002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. 35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

2. Claims 1,15,16,18,19, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, claims 1,15,16,18,19, only recite an abstract idea. The recited steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all.

For claim 1, due in part to the indefiniteness of the scope of the claim language (which will be addressed under 35 USC 112,2nd), the examiner feels that using the broadest reasonable interpretation for the claim language, claim 1 is not statutory. The reason is that the means for accessing the weight could be a person asking the user for

their weight and the step of assigning the weight into categories can be done mentally. The ski indicia is just like a limitation to data. For this reason the scope of claim 1 includes the situation where the means language is a person and the indicia is not a tangible physical thing, so the claim is drawn to nonstatutory subject matter (people and indicia).

For claim 15,16,18,19, the claims do not require the use of any technology and are not statutory. All of the recited steps could be done mentally or vocally, which is not considered to be statutory subject matter. The use of a chart in claim 16 is not a recitation of technology that would render the claim statutory. A chart is just a piece of paper with written matter, which is not considered technology.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11,15-20, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, the examiner is not clear as to what the scope of the claim is overall. The scope of the language concerning the "means for accessing the unannounced weight of the user" and the "means for assigning said accessed user weight into one of a set .....to said selected user weight range" does not appear to be limited in the instant specification. One could argue that the means language of claim 1 could be a person. A person could ask for a user's weight by whispering and then could mentally assign it

to a weight range category. Is the means language broad enough to read on this type of interpretation? The scope of this language is not clear to the examiner.

For claim 2, how can a chart be a means to "access an unannounced weight"? How is the chart capable of accessing anything at all? A chart is a piece of paper with written matter on it. How can the function of the means language be performed by paper? The positive recitation of a chart is in contradiction to the functional part of the means language because it does not appear that the chart can do what is claimed. Also, if the user can compare an announced weight, when known, if the weight is known it has to have been announced at some point in time, so how can it be called an announced weight?

For claim 3, the preamble states "The system of claim 1, *further* comprising:" which means that the following limitations are in addition to what has already been claimed. Then applicant recites a weighing station and platform but then goes on to say that the limitation of "means for accessing the unannounced weight" is the weighing station and the platform. The language "further comprising" is in contradiction to language that says the limitation of claim 3 is a limitation from claim 1, (two different recited elements are not the same thing?).

For claim 4, if the user can input their weight into the user interface, if the weight is known to the user it has to have been announced at some point in time, so how can it be called an announced weight? This dose not make any sense.

For claim 15-20, if one is to access the weight of a user, how can this be done without disclosing the weight? If a user steps on a scale, the physical act of stepping on

the scale is a disclosure of the weight. It is not a verbal disclosure but the weight is disclosed by stepping on the scale. The portion of the claim that recites accessing unannounced weight without disclosing the weight is indefinite and makes no sense.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by a ski rental shop at any ski resort.

For claims 12-14, with respect to the language "designed for use with" and the associated language describing the means for accessing and the means for assigning, this is simply the intended use of the skis and has not been given patentable weight other than to the extent that a group of skis of the prior art can be used in a system as recited. Claim 12 is just directed to a group of skis, where the means for accessing and means for assigning is not part of the claimed invention in claim 12. Claim 12 reads on a collection of skis at a ski shop. The examiner takes "Official Notice" that a collection of skis with indicia on the skis, such as length, were known more than one year before the filing date of this application. The instant examiner has personally skied in Vermont, NY State, Quebec, Canada and every one of those places had a collection of skis with indicia written on them. With respect to the limitation about the ski indicia, this is just interpreted to be written matter. Because the means for accessing and means for

assigning are not part of claim 12, reciting that the indicia of the skis corresponds to an unclaimed element (namely the encrypted weight indicator) is meaningless.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schneider (5123494) and Jones et al. (5157601) disclose a method where a weight is accessed and is encoded in some manner.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER